

REMARKS

In the Office Action dated August 11, 2004, the Examiner objected to claim 23 for informalities; provisionally rejected claims 1-24 under 35 U.S.C. §101; rejected claims 25-29 under 35 U.S.C. § 112, first paragraph; rejected claim 10 under 35 U.S.C. § 112, second paragraph; rejected claims 1-4 and 68 under 35 U.S.C. §103(a) as being unpatentable over Mize et al., U.S. Patent Publication No. 2003/0124025; rejected claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Rupp, U.S. Patent No. 5,261,460; and rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Stewart et al., U.S. Patent Publication No. 2003/0037812.

By this amendment, Applicants cancel claims 1-24, amend claim 29, and add new claims 30-36. Claims 25-36 are pending.

Claim 29 is amended to correct a minor typographical error. The amendment does not narrow the scope of claim 29. In view of the provisional rejection under 35 U.S.C. § 101, claims 1-24 have been cancelled. Applicants do not acquiesce in any of the prior art rejections of claims 1-24 and indeed traversed similar rejections in co-pending application number 10/422,708.

Applicants respectfully submit that pending claims 25-36 are in condition for allowance.

The Examiner's rejection of claims 25-29 under 35 U.S.C. § 112, first paragraph, is respectfully traversed. Applicants respectfully submit that the specification enables one of ordinary skill in the art to make and use the claimed invention as required by 35 U.S.C. § 112, first paragraph. For example, page 21 of the specification discloses, "[I]t is further preferred to create multiple conditions of readiness based on the possible arrival time of such winds." The specification then describes five example conditions of

readiness. As shown by this one example, the specification enables one of ordinary skill in the art to practice the claimed steps of “establishing a plurality of conditions of readiness . . .” and “establishing at least one condition of readiness . . .” Therefore, the rejection under 35 U.S.C. § 112, first paragraph, must be withdrawn.

In rejecting claims 25-29 under 35 U.S.C. § 112, first paragraph, the Examiner misstates both the law and the facts.

The Examiner interprets In re Mayhew, 527 F.2d 1229 (C.C.P.A. 1976) as condoning a rejection under 35 U.S.C. § 112, first paragraph, because the applicant did not claim certain disclosed conditions. However, both the Court of Appeals for the Federal Circuit and the U.S. Patent and Trademark Office reject this interpretation. According to the Federal Circuit, Mayhew applied to method claims that “omitted a step without which the invention as claimed was wholly inoperative (meaning it simply would not work and could not produce the claimed product).” Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1337-1338. According to the Office, “[F]eatures which are merely preferred are not to be considered critical.” M.P.E.P. § 2164.08(c). The Office further cautions:

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Id.

The specification does not state that establishing certain conditions is critical or essential to the invention, and the Examiner fails to provide any citation to the specification in support of the enablement rejection. Indeed, page 21 of the

specification identifies the step of establishing conditions of readiness as "preferred." Therefore, in accordance with M.P.E.P. § 2164.08(c), the rejection under 35 U.S.C. § 112, first paragraph, must be withdrawn.

Claims 25-29 were not rejected in view of prior art, and therefore are in condition for allowance.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 26, 2005

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